

Serial No. 10/665,946

**REMARKS**

The Office action dated September 8, 2004 and the cited references have been carefully considered.

**Status of the Claims**

Claims 1-5 are pending. Claim 21 is new, reciting patentable subject matter disclosed in the original specification or claims.

Claim 3 is objected to as being dependent on a rejected base claim, but would be allowable if rewritten in independent form. Claim 3 has been rewritten in independent form to include all of the limitations of the base claim and any intervening claims. Therefore, claim 3 is now in condition for allowance. Early allowance is respectfully requested.

Claims 1, 2, 4, and 5 are rejected under 35 U.S.C. § 102(b) as being anticipated by Toyoshima (U.S. Patent 4,954,586). Claims 1, 2, 4, and 5 are rejected under 35 U.S.C. § 102(b) as being anticipated by Broer (U.S. patent 4,718,748). The applicants respectfully traverse all of these rejections for the reasons set forth below.

**Remarks on the Amendments to the Claims**

The subscripts on the methylene groups in claims 1 and 3 have been amended to clarify that the number of methylene units is generally different from the number of the –O-Si(R<sub>1</sub>)(R)- groups of the macromonomer. One having ordinary skill in the art expects that they differ from each other. For example, the specification discloses that the number of methylene groups depends on the type of methacrylate-containing monomer (see; e.g., non-limiting examples of these monomers in paragraph [0018]). However, the number of the –O-Si(R<sub>1</sub>)(R)- groups depends on the type of cyclic siloxane used (see; e.g., paragraph [0016]).

Support for the limitation of “each R group comprises an aromatic group covalently attached to a linking group” is found, for example, in the non-limiting examples of the aromatic-based side groups disclosed in paragraph [0015] and Table 1 of the original

Serial No. 10/665,946

specification. The applicants wish to emphasize that although the scope of the claims is not limited by any particular embodiment of the claimed invention, a method of synthesizing an aromatic-based siloxane macromonomer of the present invention is disclosed in paragraph [0016]. Such a macromonomer can be made by a two-step process. In the first step, a silicone hydride-containing macromonomer is made. In the second step, this silicone-hydride macromonomer is reacted with an allylic functionalized aromatic to attach the aromatic group to the silicon atom. Thus, the side group R comprises the aromatic group covalently attached to the linking group.

**Claim Rejection Under 35 U.S.C. § 102**

Claims 1, 2, 4, and 5 are rejected under 35 U.S.C. § 102(b) as being anticipated by Toyoshima. The applicants respectfully traverse this rejection because Toyoshima does not disclose each and every element of each of claims 1, 2, 4, and 5.

"[A]n invention is anticipated if the same device, including all the claim limitations, is shown in a single prior art reference. Every element of the claimed invention must be *literally* present, arranged as in the claim. . . . The identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989) (emphasis added).

Toyoshima discloses only that some side groups are phenyl. See; e.g., column 3, lines 35-37; and column 5, lines 1-3, 31-34.

In contradistinction, each of claims 1, 2, 4, and 5 recites side groups R comprising an aromatic group covalently attached to a linking group.

Since Toyoshima does not disclose each and every element of each of claims 1, 2, 4, and 5, Toyoshima does not anticipate these claims.

Claims 1, 2, 4, and 5 are rejected under 35 U.S.C. § 102(b) as being anticipated by Broer. The applicants respectfully traverse this rejection because Broer does not disclose each and every element of each of claims 1, 2, 4, and 5.

Serial No. 10/665,946

"[A]n invention is anticipated if the same device, including all the claim limitations, is shown in a single prior art reference. Every element of the claimed invention must be *literally* present, arranged as in the claim. . . . The identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989) (emphasis added).

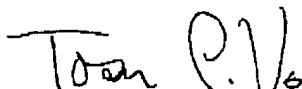
Broer discloses only generally that some side groups can be aryl groups. Column 2, lines 49-50. Broer specifically discloses further that these side groups are phenyl groups. Column 2, lines 30-45.

In contradistinction, each of claims 1, 2, 4, and 5 recites side groups R comprising an aromatic group covalently attached to a linking group. Broer's aryl groups are not aromatic groups covalently attached to a linking group, as is recited in each of claims 1, 2, 4, and 5.

Since Broer does not disclose each and every element of each of claims 1, 2, 4, and 5, Broer does not anticipate these claims.

In view of the above, it is submitted that the claims are patentable and in condition for allowance. Reconsideration of the rejection is requested. Allowance of the claims at an early date is solicited.

Respectfully submitted,



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